

REMARKS

Claims 4 through 16 are pending in this Application of which claims 8, 9 and 11 were indicated to contain allowable subject matter and claim 7 indicated allowable upon overcoming the imposed rejection under the first paragraph of 35 U.S.C. § 112. Claims 1, 2, 3 and 6 have been cancelled, claims 7, 8, 9 and 11 placed in independent form, noting that claim 8 was placed in independent form based upon intervening claim 6, and the dependency of claims 4 and 5 changed to claim 7, the dependency of claims 10 and 13 changed to claim 9, and the dependency of claims 12 and 14 changed to claim 11. In addition, new claims 15 and 16 have been added, which basically correspond to original claims 4 and 5, respectively, but made dependent upon claim 8. Applicants submit that the present Amendment does not generate any new matter issue.

Information Disclosure Statement.

A Supplemental Information Disclosure Statement is being filed addressing the issue raised by the Examiner with respect to the non-patent literature publications.

Claim Objection.

The Examiner objected to claim 8 pursuant to 37 C.F.R. § 1.75(c), as failing to limit a previous claim.

This objection is traversed. Indeed, this rejection has been overcome by placing claim 8 in independent form based upon intervening **claim 6**. Accordingly, withdrawal of the objection to claim 8 is solicited.

Claim 7 was rejected under the first paragraph of 35 U.S.C. § 112.

In the statement of the rejection the Examiner acknowledged that the originally filed disclosure provides adequate enabling support for uranium oxyfluoride or uranyl fluoride. However, the Examiner concluded that the originally filed disclosure does not provide adequate enablement for uranium fluoride. This rejection is traversed as legally erroneous.

Lack of enablement under the first paragraph of 35 U.S.C. § 112 is a question of law. *U.S. Steel Corp. v. Philips Petroleum Co.*, 865 F.2d 1247, 9 USPQ2D 1461 (Fed. Cir. 1989); *U.S. v. Teletronics Inc.*, 857 F.2d 778, 8 USPQ2d 1217 (Fed. Cir. 1988). In rejecting a claim under the first paragraph of 35 U.S.C. § 112 for lack of adequate enabling support, it is incumbent upon the Examiner to establish a basis in fact and/or cogent technical reasoning to support the ultimate legal conclusion that one having ordinary skill in the art would not be able to practice the claimed invention, armed with the supporting specification, without undue experimentation. *In re Cortright*, 165 F.3d 1353, 49 USPQ2d 1464 (Fed. Cir. 1999); *In re Brana*, 51 F.2d 1560, 34 USPQ2d 1436 (Fed. Cir. 1995); *In re Marzocchi*, 439 F.2d 220, 169 USPQ 367 (CCPA 1971). Applicants emphasize that a patent disclosure is directed to one having ordinary skill in the art. *In re Howarth*, 654 F.2d 103, 210 USPQ 589 (CCPA 1981). Moreover, and quite significantly, it has been repeatedly held that the scope of enablement varies inversely with the degree of predictability in the art, i.e., enablement is a function of the complexity of the involved subject matter. *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990); *U.S. v. Teletronics Inc.*, *supra*. Applicants stress that a patent specification is **presumed enabling** in the absence of a reason to doubt the objective truth of the statements contained therein. *In re Cortright*, *supra*; *In re Brana*, *supra*; *In re Marzocchi*, *supra*.

In applying the above legal tenets to the exigencies of this case, Applicants submit that the Examiner has not establish a *prima facie* basis to deny patentability to the claimed invention under the first paragraph of 35 U.S.C. § 112 for lack of adequate enabling support. Specifically, the Examiner did not overcome the presumption of enablement, as by advancing technological reasoning to doubt the statements in the specification, or by establishing that the claimed invention is inherently unbelievable or involves implausible scientific principles. *In re Cortright, supra*. Indeed, it is inconceivable that one having ordinary skill in the art, out in the real world, would have been able to practice the claimed invention for uranium oxyfluoride and uranyl fluoride, but somehow would have drawn a mental blank when it comes to uranium fluoride. Bearing in mind that the disclosure is presumed enabling, the Examiner did not provide one shred of **objective evidence** inconsistent with the disclosure, or otherwise established that the claimed invention is inherently unbelievable or involves implausible scientific principles. *In re Cortright, supra*.

Applicants submit that one having ordinary skill in the art would have no difficulty practicing the claimed invention based upon the originally filed disclosure. In this respect, the Examiner's attention is invited to page 8 of the written description of the specification, line 25 where "U fluoride" is disclosed. Again, there is no apparent factual basis of record inconsistent with the presumption that the scope of enablement provided by the originally filed disclosure is reasonably commensurate with the scope of claim 7. *In re Cortright, supra; In re Brana, supra; In re Marzocchi, supra*.

Applicants, therefore, submit that the imposed rejection of claim 7 under the first paragraph of 35 U.S.C. § 112 for lack of adequate enabling support is not legally viable and, hence, solicit withdrawal thereof.

Claims 1 and 4 through 6 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Fukasawa in view of Golliher.

Claims 2, 3 and 12 through 14 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Fukasawa in view of Golliher and Anastasia.

Claim 10 was rejected under 35 U.S.C. § 103 for obviousness predicated upon Fukasawa in view of Golliher, Anastasia and Caranoni.

Each of the above rejections under 35 U.S.C. § 103 is traversed. Indeed, each of the above rejections under 35 U.S.C. § 103 has been rendered moot by canceling claims 1, 2, 3 and 6, making claims 4 and 5 dependent from claim 7, indicated allowable, making claims 12 and 14 dependent upon claim 11, indicated allowable, and making claims 10 and 13 dependent upon claim 9, indicated allowable. Accordingly, withdrawal of the above rejections under 35 U.S.C. § 103 is solicited.

New claims 15 and 16.

New claims 15 and 16 are clearly free of the applied prior art by virtue of their dependence upon independent claim 8, indicated allowable.

Based upon the foregoing it should be apparent that the imposed objection and rejections have been overcome, and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, solicited.

Application No.: 10/761,432

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Arthur J. Steiner

Registration No. 26,106

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 AJS:bjs:ntb
Facsimile: 202.756.8087
Date: August 1, 2006

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